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Attorney Docket No. 28955.1071

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Confirmation No. 3180

Takahisa MURAMOTO, et al.

Serial No.: 10/587,048

Art Unit: 1797

Filed: July 24, 2006

Examiner: Dirk R. Bass

For: METHOD FOR TREATING RAW WATER CONTAINING HARDLY DECOMPOSABLE SUBSTANCE

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APPLICANTS' ATTORNEYS' INTERVIEW SUMMARY  
AND  
RESPONSE TO EXAMINERS' JUNE 16, 2010 INTERVIEW SUMMARY

This response relates to the telephone interviews conducted on June 15, 2010 initiated by applicant's attorney Ms. Houda Morad, with Examiners Bass and Menon, and later on June 15, 2010 initiated by applicant's attorneys Roger W. Parkhurst and Houda Morad with Examiner Bass.

With respect to both of the aforementioned June 15, 2010 telephone interviews, the first and fifth sentences of page 2 of the Examiners' Interview Summary mailed June 16, 2010 state the substance of the positions stated by applicants' attorneys during those interviews.

The Advisory Action mailed June 14, 2010, page 2, accurately states that applicants contend that EP 1591422 is not eligible as prior art against the instant U.S. application.

Applicants hereby confirm that the November 2, 2005 publication date of EP '422 is after the

January 20, 2005 effective filing date of the present application, so that EP '422 is not prior art against the present application as a matter of law. Contrary to the statement in the Advisory Action, nothing in this record "allows EP 1591422 to be qualified as prior art under 35 U.S.C. 102(a)."

Further, and contrary to the erroneous second sentence in the June 14, 2010 Advisory Action, page 2, applicants directed the attention of the USPTO to the publication date of WO 2004/067453, the publication of a PCT application corresponding to EP '422. Thus, it is only WO 2004/067453, not EP '422, which might have been cited under 35 U.S.C. 102(a). In fact, however, the USPTO has not cited WO '453 as the basis for a §102(a) rejection of applicants' claims. Nevertheless, applicants filed a Declaration, signed by the named authors of the WO '453 publication (except the deceased Mr. Motoshi Suzuki who has submitted no evidence contrary to that Declaration) who were not also named inventors on the instant U.S. application, affirmatively stating that "all possibly relevant portions of Suzuki WO '453, originated with, or were obtained from, the inventors of the above-identified application," i.e., the instant U.S. application Serial No. 10/587,048.

Applicants cited MPEP 2132.01 (annotated copy attached hereto) because that MPEP section expressly explains how "APPLICANT CAN REBUT *PRIMA FACIE* CASE BY SHOWING REFERENCE'S DISCLOSURE WAS DERIVED FROM APPLICANT'S OWN WORK." More specifically, MPEP 2132.01 also states that

... where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from applicant.

Such affidavits or declarations are particularly probative of such facts because they are statements by the authors of a cited publication stating, against their own interest, that the portions of the publication relevant as prior art to a pending application were in fact obtained from the applicant(s) of such pending application.

For the foregoing reasons, and in view of the case law precedents cited in MPEP 2132.01, the statement at page 2 of the June 14, 2010 Advisory Action, “Applicant’s affidavit is not persuasive since the inventive entities recited in the current application and EP 1591422 are in fact different,” states an erroneous conclusion based on an irrelevant fact. As clearly recognized in MPEP 2132.01, the authors named on a publication cited under §102(a) are usually different from the named inventive entity in the pending application against which such publication is cited.

Returning now to the statements made in the June 16, 2010 Interview Summary, page 2, commencing with the second sentence on that page, the Summary says that the PTO “believes this declaration is insufficient in precluding Suzuki from being used as prior art for two reasons. First, applicant has not provided that Motoshi Suzuki has or has not made a contribution to the application in question.” Although Suzuki did not sign the affidavit (because he is deceased), there is no evidence that he refused to disclaim inventorship and believes himself or herself to be an inventor (see MPEP § 2132.01). In addition, we understand that the words “the application in question” to refer to the instant pending U.S. application Serial No. 10/587,048. Applicants point out that Mr. Motoshi Suzuki is not a named inventor on the instant application. There is no relevant question concerning whether or not Mr. Suzuki “made a contribution to the application

in question.” Thus the first “reason” stated in the June 16, 2010 Interview Summary is irrelevant.

The June 16, 2010 Interview Summary then states

Secondly, the inventive entity of the current application and the prior art are shown to be different therefore allowing the prior art to be used as a 102(a) reference. \* \* \* The examiners maintain that since the prior art reference is by “another” and was published or known before the application for patent, the prior art reference cannot be overcome unless applicant swears behind the reference.

In effect, the June 16, 2010 Interview Summary takes the position that the very type of disclaiming affidavit expressly approved by MPEP 2132.01 cannot rebut a §102(a) rejection. The well-reasoned logic of MPEP 2132.01 is that if the cited publication is in fact a publication of the applicants’ own work, such publication could not have been before the invention of that subject matter by applicants. MPEP 2132.01 and the cases cited therein belie the PTO’s stated position in this case, as a matter of law. And the Declaration filed herein satisfies MPEP 2132.01 and moots any rejection that might have been based on WO ‘453.

Finally, applicants again refer to the fact that EP ‘422 (the cited basis of the 2/18/10 stated final rejections) has been conclusively demonstrated not to be de jure prior art available against the instant application. Thus, any rejection based upon EP ‘422 is without merit and moot. The PTO should withdraw the final Office Action mailed February 18, 2010, and allow applicants’ claims.

Respectfully submitted,

STEPTOE & JOHNSON LLP

Date: June 17, 2010

A handwritten signature in black ink, appearing to read "Roger W. Parkhurst", written over a horizontal line.

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**2132.01 Publications as - 2100 Patentability****2132.01 Publications as 35 U.S.C. 102(a) Prior Art****35 U.S.C. 102(a) *PRIMA FACIE* CASE IS ESTABLISHED IF REFERENCE PUBLICATION IS "BY OTHERS"**

A *prima facie* case is made out under **35 U.S.C. 102(a)** if, within 1 year of the filing date, the invention, or an obvious variant thereof, is described in a "printed publication" whose authorship differs in any way from the inventive entity unless it is stated within the publication itself that the publication is describing the applicant's work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). See **MPEP § 2128** for case law on what constitutes a "printed publication." Note that when the reference is a U.S. patent published within the year prior to the application filing date, a **35 U.S.C. 102(e)** rejection should be made. See **MPEP § 2136 - § 2136.05** for case law dealing with 102(e).

**APPLICANT CAN REBUT *PRIMA FACIE* CASE BY SHOWING REFERENCE'S DISCLOSURE WAS DERIVED FROM APPLICANT'S OWN WORK**

Applicant's disclosure of his or her own work within the year before the application filing date cannot be used against him or her under **35 U.S.C. 102(a)**. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982) (discussed below). Therefore, where the applicant is one of the co-authors of a publication cited against his or her application, the publication may be removed as a reference by the filing of affidavits made out by the other authors establishing that the relevant portions of the publication originated with, or were obtained from, applicant. Such affidavits are called disclaiming affidavits. *Ex parte Hirschler*, 110 USPQ 384 (Bd. App. 1952). The rejection can also be overcome by submission of a specific declaration by the applicant establishing that the article is describing applicant's own work. *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982). However, if there is evidence that the co-author has refused to disclaim inventorship and believes himself or herself to be an inventor, applicant's affidavit will not be enough to establish that applicant is the sole inventor and the rejection will stand. *Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. & Int. 1982) (discussed below). It is also possible to overcome the rejection by adding the coauthors as inventors to the application if the requirements of **35 U.S.C. 116**, third paragraph are met. *In re Searles*, 422 F.2d 431, 164 USPQ 623 (CCPA 1970).

In *In re Katz*, 687 F.2d 450, 215 USPQ 14 (CCPA 1982), Katz stated in a declaration that the coauthors of the publication, Chiorazzi and Eshhar, "were students working under the direction and supervision of the inventor, Dr. David H. Katz." The court held that this declaration, in combination with the fact that the publication was a research paper, was enough to establish Katz as the sole inventor and that the work described in the publication was his own. In research papers, students involved only with assay and testing

are normally listed as coauthors but are not considered co-inventors.

In *Ex parte Kroger*, 219 USPQ 370 (Bd. Pat. App. & Inter. 1982), Kroger, Knaster and others were listed as authors on an article on photovoltaic power generation. The article was used to reject the claims of an application listing Kroger and Rod as inventors. Kroger and Rod submitted affidavits declaring themselves to be the inventors. The affidavits also stated that Knaster merely carried out assignments and worked under the supervision and direction of Kroger. The Board stated that if this were the only evidence in the case, it would be established, under *In re Katz*, that Kroger and Rod were the only inventors. However, in this case, there was evidence that Knaster had refused to sign an affidavit disclaiming inventorship and Knaster had introduced evidence into the case in the form of a letter to the PTO in which he alleged that he was a co-inventor. The Board held that the evidence had not been fully developed enough to overcome the rejection. Note that the rejection had been made under **35 U.S.C. 102(f)** but the Board treated the issue the same as if it had arisen under **35 U.S.C. 102(a)**. See also case law dealing with overcoming 102 (e) rejections as presented in **MPEP § 2136.05**. Many of the issues are the same.

### **A 37 CFR 1.131 AFFIDAVIT CAN BE USED TO OVERCOME A 35 U.S.C. 102(a) REJECTION**

When the reference is not a statutory bar under **35 U.S.C. 102(b)**, (c), or (d), applicant can overcome the rejection by swearing back of the reference through the submission of an affidavit under **37 CFR 1.131**. In *re Foster*, 343 F.2d 980, 145 USPQ 166 (CCPA 1965). If the reference is disclosing applicant's own work as derived from him or her, applicant may submit either a **37 CFR 1.131** affidavit to antedate the reference or a **37 CFR 1.132** affidavit to show derivation of the reference subject matter from applicant and invention by applicant. In *re Facius*, 408 F.2d 1396, 161 USPQ 294 (CCPA 1969). See **MPEP § 715** for more information on when an affidavit under **37 CFR 1.131** can be used to overcome a reference and what evidence is required.

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